

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
VOS *et al.*

Application No.: 10/727,997

Filed: 4 December 2003

For: MODULATORS OF MELANOCORTIN
RECEPTOR

Confirmation No.: 7133

Art Unit: 1626

Examiner: R. Armstrong
(formerly K. Cheng)

Attorney Docket No.: 29984-208422
(formerly MPI02-196PIRNM)

Customer No.:

26694

PATENT TRADEMARK OFFICE

FAX RECEIVED

SEP 06 2007

OFFICE OF PETITIONS

**Petition to Withdrawn from Issue under 37 C.F.R. § 1.313 and
to Reconsider Response to Rule 312 Communication, or,
Alternatively, Enter Request for Continued Examination**

MAIL STOP PETITIONS

Assistant Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants hereby petition that the above-identified application be withdrawn from issue. Applicants submit that the United States Patent and Trademark Office (USPTO) should withdraw the application from issue under 37 C.F.R. § 1.313(b)(1), because a mistake was made on the part of the USPTO. Should this petition be denied on this ground, Applicants petition for withdrawal from issue under 37 C.F.R. § 1.313(e)(2) and that the attached Request for Continued Examination be entered. Prompt action on this petition is requested, as publication of the patent on 18 September 2007 has been indicated on an Issue Notification.

09/06/2007 CMC/LOM 00000024 220251 10727997

09/06/2007 15:00 DA

Request for Reconsideration

Applicants submit that a mistake has been made on the part of the U.S. Patent and Trademark Office (USPTO), and that the USPTO should withdraw the above-identified application from issue under 37 C.F.R. § 1.313(b)(1).

On 22 June 2007, Applicants filed an Amendment Under 37 C.F.R. § 1.312 with the objective of amending claim 33 to render it independent and of adding claims 36 and 37. Applicants received a Response to Rule 312 Communication mailed 16 August 2007 for the above-identified application, indicating that the Amendment had been disapproved, because in the Listing of Claims, the status identifier for claims 23-32 and 35 was given as "withdrawn", when in fact these claims had been canceled.

Although Applicants agree that claims 23-32 and 35 should have been designated as "canceled", Applicants understand that the Amendment Under 37 C.F.R. § 1.312 should not have been disapproved for incorrectly identifying the status of these claims. MPEP 714.16 states that "[i]f the [37 C.F.R. § 1.312] amendment is non-compliant under 37 CFR 1.121 and the entry of the amendment would have been otherwise recommended, the examiner may enter the amendment and correct the non-compliance (e.g., an incorrect status identifier) using an examiner's amendment." Furthermore, MPEP 714.16(e) states that "when, under 37 CFR 1.312, an amendment, for example, is proposed containing a plurality of claims or amendments to claims, some of which may be entered and some not, the acceptable claims or amendments should be entered in the application ... The examiner should then submit a Response to Rule 312 Communication form PTO-271 recommending the entry of the acceptable portion of the amendment and the nonentry of the remaining portion together with his or her reasons therefor."

In light of MPEP 714.16, Applicants respectfully request reconsideration of the Response to Rule 312 Communication of 16 August 2007 and entry of the amendment to claim 33 and new claims 36 and 37 as requested in the Amendment Under 37 C.F.R. § 1.312 filed 22 June 2007, and correction by examiner's amendment of the status identifier of claims 23-32 and 35 to "canceled". Applicants understand that this is the procedure which should have been followed by the U.S. Patent and Trademark Office (USPTO) prior to the issuance of a Response to Rule 312 Communication.

Applicants note that the Examiner who disapproved the Amendment under 37 C.F.R. § 1.312, the Examiner who carried out the bulk of the examination, and the current Examiner assigned the above-identified application are all different individuals. Applicants may have been prejudiced by these changes in responsibility for this application.

Request for Continued Examination

If the USPTO determines that, for some reason, the procedure outlined in MPEP 714.16 is not to be followed, then, in the interest of ensuring the issuance of a patent with a proper claim set, Applicants petition for withdrawal for the above-identified application from issue under 37 C.F.R. § 1.313(c)(2), and file a Request for Continued Examination with an Amendment, in which claim 33 is amended to render it independent and claims 36 and 37 are added, along with the required fees.

The last papers filed by applicants in the above-identified application are the Issue Fee Transmittal and an Amendment under 37 C.F.R. § 1.312, which were filed on 22 June 2007.

REMARKS


Given that the issue date for the above-identified application has been indicated as 18 September 2007, Applicants respectfully request prompt consideration of this petition.

Attached hereto is a Request for Continued Examination and an Amendment, to be applied if the USPTO determines that the procedure of MPEP 714.16 is not to be followed and the Amendment Under 37 C.F.R. § 1.312 filed on 22 June 2007 is not to be entered.

Should further communication be useful in expediting the processing of the above-identified application, Applicants invite the responsible USPTO personnel to contact the undersigned by telephone.

Respectfully submitted,

Dated: September 6, 2007



Lars H. Genieser, Ph.D.
Registration No. 46,722

Keith G. Haddaway, Ph.D.
Registration No. 46,180
VENABLE LLP
P.O. Box 34385
Washington, D.C. 20043-9998
Telephone: (202) 344-4000
Telefax: (202) 344-8300

DC2/889755